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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/361,829 07/27/99 HEATH

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027073 HM12/1011  
FOGG SLIFER & POLGLAZE, P.A.  
P.O. BOX 581009  
MINNEAPOLIS MN 55458-1009

EXAMINER

ALLEN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/361,829

Applicant(s)

HEATH ET AL.

Examiner

Marianne Allen

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's arguments filed 7/9/01 have been fully considered but they are not persuasive.

### ***Election/Restrictions***

Claims 20-22 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

### ***Claim Rejections - 35 USC § 103***

Claims 1-7, 9-10, and 14-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al. (U.S. Patent No 5,773,221, June 30, 1998) in view of Kelley et al. (U.S. Patent No. 5,679,154, October 21, 1997), in view of Vogel et al. (U.S. Patent No. 5,922,320, July 13, 1999), in view of Pfof et al. (U.S. Patent No. 5,369,566, November 29, 1994), in view of Bacus et al. (U.S. Patent No. 4,175,860, November 27, 1979).

This rejection is maintained for reasons of record.

Applicant argues that Vogel et al. discloses using aspiration to avoid shearing of DNA but that applicant's invention could embrace aspirating in such a way that DNA was sheared. Applicant is improperly reading limitations from the specification into the claims. The claims do not require any particular type of aspiration (to avoid and/or enhance shearing) and as such, a suggestion in the prior art to use aspiration for any purpose is sufficient to render the claims obvious. Applicant's arguments regarding Bacus et al. are not persuasive. Bacus et al. is relied upon to establish the advantages and desirability of automation. Applicant is inviting an enablement rejection based upon their arguments as their specification does not exemplify any aspect of their invention but merely discloses a blueprint or flow diagram and leaves it to one of ordinary skill in the art to implement. It is further noted that the claims do not require any particular order for the different commands to be executed. That is, the particular method flow

in the figures is not a limitation of the claims. In particular, claim 6 does not require any particular nucleic acid isolation functions. Thus, when taken as a whole, the prior art clearly suggests the invention as claimed.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson, Kelley, Vogel, Pfof, and Bacus as applied to claims 1-7, 9-10, and 14-18 above, and further in view of Thrush (U.S. Patent No. 5,692,144, November 25, 1997).

This rejection is maintained for reasons of record in view of the above remarks.

Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson, Kelley, Vogel, Pfof, and Bacus as applied to claims 1-7, 9-10, and 14-18 above, and further in view of Johnson et al. (U.S. Patent No. 5,584,039, December 10, 1996)

This rejection is maintained for reasons of record in view of the above remarks.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable Carlson, Kelley, Vogel, Pfof, and Bacus as applied to claims 1-7, 9-10, and 14-18 above, and further in view of Poulter et al. (U.S. Patent No. 6,072,795, June 6, 2000).

This rejection is maintained for reasons of record in view of the above remarks.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable Carlson, Kelley, Vogel, Pfof, and Bacus as applied to claims 1-7, 9-10, and 14-18 above, and further in view of McNutt (U.S. Patent No. 5,802,389, September 1, 1998)

This rejection is maintained for reasons of record in view of the above remarks.

### **Conclusion**

No claims are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

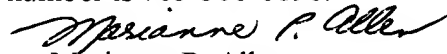
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 9:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Marianne P. Allen  
Primary Examiner  
Art Unit 1631

mpa  
October 9, 2001